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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/626,148

07/24/2003

David Ciano

058420-005

9317

27805

7590

04/08/2009

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EXAMINER

HOEL, MATTHEW D

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

04/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|--|--------------------------------------|---------------------------------------|--|
| <p align="center">Advisory Action Before the Filing of an Appeal Brief</p> | Application No. 10/626,148 | Applicant(s) CIANCIO ET AL. | |
| | Examiner Matthew D. Hoel | Art Unit 3714 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-24 and 26-55.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: _____.

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714

/M. D. H./
Examiner, Art Unit 3714

Continuation of 3. NOTE: nine new claims (56-64); four claims presently cancelled (43,46,48,49).

Dependent claims 43, 46, 48, & 49 are cancelled and new claims 56 to 64 are presented, so a corresponding number of finally rejected claims have not been cancelled as indicated above. Claims 56 to 64 will require a new search and consideration of novelty and non-obviousness. The Bilski amendments to ind. Claims 1, 24, and 45 are acceptable, but the new non-Bilski limitations into these claims and claims 26 and 33 will require new search and consideration of novelty and non-obviousness. The examiner had provided Bilski suggestions in the last action. The independent claims, while better than previously amended for 101 purposes, are still not specific enough to show how the specific structure of an apparatus carries out the specific steps of accepting selection of categories, accepting purchases from customers, or remitting awards to customers. The claims have been merely written to include a computer. The selection of categories could be done by keyboard, mouse, touchscreen, etc. The accepting of purchases could be done by keyboard, mouse, touchscreen, credit/debit card reader/writer, POS terminal, bill/coin slot/hopper, etc. The remitting of an award to the customer could be done by credit/debit card reader/writer, POS terminal, bill/coin slot/hopper, etc. The specific steps have not been sufficiently tied to specific apparatus structure. The new undetermined reward of Claims 1 and 45 is a negative limitation which appears to be indefinite and does not appear to be enabled or described by the specification, for example, these claims do not cite how the reward is determined. While the independent claims do not pertain to a subscription system, the examiner believes that the claim language does not preclude the subscription systems of '262 and '573 from being used as the examiner did not rely on a citation of a subscription against the claims. An undetermined award appears to be anticipated by '262, Fig. 11, 9:51-10:15, in which internal conditions such as existing frequency and duration of purchases and subscriptions are randomly selected and also external conditions are randomly used. Regarding the '262 18:60-64 and 19:28-46 passages cited by the applicants, the subscription renewal offer is made after the plurality of discrete purchases as presently claimed. The reward may be a single i) coupon for the monetary amount, usable for purchases at the business; ii) a cash payment; iii) a credit to a financial account associated with the customer, iv) an increase of the deposit previously paid for by the customer; or v) any combination thereof. '262, 19:5-20 describes a subscription price being set at the time of a renewal offer by looking up in a database, after the plurality of discrete purchases. Regarding the comments on page 15, each category of '262 Fig. 6 (7:20-38) can include a plurality of goods. Category C5 includes both diapers and a jar of baby food, both of which are items used in caring for infants.